



13 FEB 2007

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In re Application of :  
GRAMATIKOVA *et al* :  
U.S. Application No.: 10/511,875 :  
PCT No.: PCT/US2003/012556 :  
Int. Filing Date: 21 April 2003 :  
Priority Date: 19 April 2002 :  
Attorney Docket No.: 564462004201 :  
For: PHOSPHOLIPASES, NUCLEIC ACIDS :  
ENCODING THEM AND METHODS :  
FOR MAKING AND USING THEM :

**DECISION**

This decision is in response to applicants' "Petition Under 37 CFR §1.47(a)" filed with the United States Designated/Elected Office (DO/EO/US) on 18 October 2005.

**BACKGROUND**

On 18 April 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b), sequence listing and a surcharge fee was required. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 18 October 2005, applicants filed the subject petition which was accompanied by, *inter alia*, the petition fee; a four-month extension and fee; the surcharge fee; a declaration of Lynn Linkowski and exhibits A-E.

**DISCUSSION**

Applicants claim that co-inventor, Svetlana Gramatikova, refuses to cooperate in the subject application and have filed a petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 18 April 2005.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

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Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (3), the last known address of co-inventor Svetlana Gramatikova is listed as:

5709 Erlanger  
San Diego, CA 92122

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the four named co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) are satisfied.

Regarding item (2), petitioners claim that the nonsigning inventor refuses to join in the application. Applicants' burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . . .

Proof that a bona fide attempt was made to present a copy of the application papers (**specification, including claims, drawings, and oath or declaration**) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

In this case, petitioners claim that the nonsigning inventor was provided a copy

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of another application (U.S. Application No. 10/421,654) having the same specification. As such, petitioners did not provide Ms. Gramatikova with a complete copy of the subject application but only a copy of the declaration and assignment.

That is unacceptable.

In order to meet the requirements of the MPEP above with regards to a refusal to join, petitioners must provide the nonsigning inventor with a complete copy of the application papers, *i.e.*, specification, including **claims**, drawings, and oath or declaration.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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